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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/435,504	11/06/1999	DENNIS SUNGA FERNANDEZ	FERN-P006	5319

22877 7590 05/08/2003

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EXAMINER

MORGAN, ROBERT W

ART UNIT PAPER NUMBER

3626

DATE MAILED: 05/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/435,504

Applicant(s)

FERNANDEZ, DENNIS SUNGA

Examiner

Robert W. Morgan

Art Unit

3626

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.Claim(s) objected to: NONE.Claim(s) rejected: 1-12 and 21-28.Claim(s) withdrawn from consideration: NONE.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's Request of Reconsideration has been considered but fails to overcome the cited references and the finality of the previous Office Action is maintained.

In the remarks, Applicants argue in substance that, (1) neither Hoffman and O'Flaherty, teach or suggest voluntary selection by a user to access "personal genetic nucleotide profile" for automated electronic transaction; and (2) Beechman teaches away from voluntary selection by a user to access "personal genetic nucleotide profile" by citing col. 18, lines 31-46 as evidence of "discouraging individuals from revealing or otherwise permitting access to genetic test data".

In response to Applicants argument that, (1) neither Hoffman and O'Flaherty, teach or suggest voluntary selection by a user to access "personal genetic nucleotide profile" for automated electronic transaction. The Examiner respectfully submits, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, it is respectfully submitted that the O'Flaherty reference, and not Hoffman, per se, that was relied upon for the specific teaching of a consumer permitting some data collection, analysis, or dissemination of data by selecting a "0" in the global data control column (210, Fig. 3A). If the customers has indicated that his information can be disclosed to a third parties, both with his identity, and anonymously, and has allowed the data to be used to perform automated processing, the customer in essence has permitted the dissemination of this sensitive data (see: O'Flaherty: column 7, lines 10-35 and Fig. 3A-3C). Hoffman was relied on for primarily teaching an increase in proving accuracy regarding buyer's biometric identification by comparing a buyer's biometric from among a basket of other biometric and the basket being a subset of all stored biometrics in the system (see: Hoffman: column 5, lines 60-64). Thus, a proper combination of the applied references would be the incorporation of O'Flaherty's voluntary selection by a user to access data by selecting a "0" in the global data control column (210, Fig. 3A) within system as taught by Hoffman.

In response to Applicants argument that, (2) Beechman teaches away from voluntary selection by a user to access "personal genetic nucleotide profile" by citing col. 18, lines 31-46 as evidence of "discouraging individuals from revealing or otherwise permitting access to genetic test data". The Examiner respectfully submits that Beechman never was relied on for th feature of voluntary selection by a user to access "personal genetic nucleotide profile" but relied on the teachings of O'Flaherty and Hoffman fro this feature, as noted above. Applicant's remarks appear to be misdescriptive of the full teachings of the Beechman reference. In particular, Beechman notes at col. 18, lines 42-45, "For further example, President Clinton indicated recently that a law would be proposed that makes itillegal for an insurance company to restrict coverage where a person has a genetic test result indicating possible future disease is likely" (see: column 18, lines 30-45).

The Examiner respectfully submits that such a statement would encourage individuals to reveal or permit access to genetic test data, since they are subject to legal protection as a result. Thus, the Examiner disputes that Beechman's remarks provide a teaching away from the manner in which Examiner applied the reference in addressing claim limitations. As such, Applicant's reliance on the *Kloster Speedsteel AB v. Crucible Inc.* case law is inapplicable to the issue at hand. Rather, it appears that Applicant merely considers bits and pieces of Examiner's applied art individually, in a vacuum, without considering the appropriate teachings of the applied references collectively as a whole.